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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,436	07/02/2007	Alain Moussy	065691-0457	5301

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FOLEY AND LARDNER LLP
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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

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07/09/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,436	Applicant(s) MOUSSY ET AL.	
	Examiner Laura L. Stockton	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :July 26, 2006 and August 28, 2007.

DETAILED ACTION

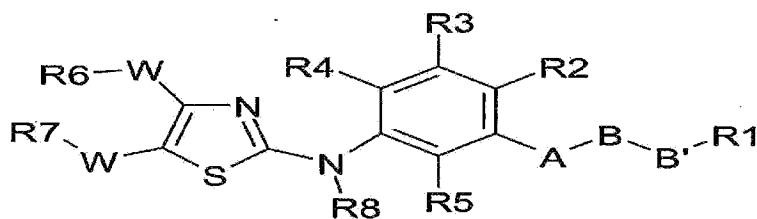
Claims 1-12 and 15 are pending in the application.

Election/Restrictions

Applicant's election with traverse of modified Group I (claims 1-12) in the reply filed on April 12, 2010 is acknowledged.

Modified Group I, as agreed upon in the telephonic interview of April 6, 2010 is as follows:

Group I. Claims 1-12 (in-part), drawn to products of formula I of claim 1



FORMULA I

wherein **A-B-B'** is CO-NH, CO-NCH₃ or CO-NR^{*}; **R**¹ is aryl; each **W** is a bond; and one of **R**⁶ and **R**⁷ is heteroaryl.

The traversal is on the ground(s) that: (1) no serious burden has been indicated for the restriction between Group I and Group IV; and (2) the restriction is allegedly erroneous because it has not been shown that the compound of CA Registry No. 33142-16-6, found in Chemical Abstract 36:44122, falls within the scope of the instant claims. This is not found persuasive because separate search considerations (i.e., separate classes/subclasses as well as different search queries) are involved for the search and examination of elected modified Group I and non-elected Group IV. Therefore, it would impose an undue burden on the Examiner and the Patent Office's resources if the instant application were not restricted.

Further, it is disagreed that the lack of unity is erroneous. As stated in the Restriction Requirement, the claimed compounds lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The

special technical feature was identified as a phenylaminothiazolyl moiety. The Restriction did not state that the special technical feature anticipated or made obvious the instant claimed invention. However, since the special technical feature was known, as indicated by the cited compound CA Registry No. 33142-16-6, the claims lacked unity of invention. Although, a compound such as Chemical Abstracts Registry Number 219314-98-4, entry date into the Registry file on STN February 5, 1999, is embraced by the broad instant claims and would anticipate the instant claimed invention if the entirety of the instant claimed invention of independent claim 1 were being examined.

The requirement is still deemed proper and is therefore made FINAL.

Subject matter not embraced by the above identified elected modified Group I and Claim 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b),

as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 12, 2010.

It is suggested that in order to advance prosecution, the non-elected product subject matter be cancelled when responding to this Office Action.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statement(s) filed on July 26, 2006 and August 28, 2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

Applicant is reminded to update the status of application(s) listed in the "Cross-Reference" on page 1 of the instant specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "having" should be changed to "of" because the use of "having" implies additional unrecited compounds.

In claim 1, under definition ii) of R⁶ and R⁷, it is not possible to have a 1 to 2 carbon cycloalkyl.

In claim 1, under definition ii) of R⁶ and R⁷, a valence problem arises when the alkyl is substituted by oxygen and nitrogen.

In claim 1, under definition ii) of R⁶ and R⁷, it is unclear if the "trifluoromethyl, carboxyl, cyano, nitro and formyl" are also possible substituents on the alkyl¹

group since an "and" is before "nitrogen" (line 11 of claim 1). It is suggested that the language be re-written for the sake of clarity {i.e., optionally substituted with a group selected from ...}

In claim 1, under definition ii) of R^6 and R^7 , a valence problem arises when the alkyl is substituted by oxygen and nitrogen. See the definitions of R^8 , R^8 , R , R^2 , R^3 , R^4 and R^5 in claim 1 and other claims for same.

In claims 1, 3, 4 and 7, it is unclear what is meant by the expressions "a pendant basic nitrogen functionality" and "a basic nitrogen functionality", which is found in several variable definitions, such as the R^6 and R^7 variables. A term is not indefinite if the determination of its meaning "is not beyond skill of the art and does not involve undue experimentation" In re Halleck, 164 USPQ 647. The expression does not meet that standard because it will involve undue experimentation. Further, if there are several different ways of calculating a parameter, and the

specification fails to indicate which method is to be employed, then the claims are indefinite, Harrah's Entertainment Inc. v. Station Casinos Inc., 71 USPQ2d 1439 (DC Nev 2004). In the instant case, the question is how is the basic nitrogen functionality determined? Is the "basic nitrogen functionality" a Lewis base or a Brønsted base? The instant specification fails to give a clear and concise definition of the expression "basic nitrogen functionality". Is the nitrogen directly attached or indirectly attached? Additionally, the claims metes and bounds cannot be ascertained since there is no structural information, other than having a nitrogen, associated with the expressions "a pendant basic nitrogen functionality" and "basic nitrogen functionality". Therefore, the expression "basic nitrogen functionality" and "a pendant basic nitrogen functionality" are indefinite.

In claim 1, under definition iv) of R^6 and R^7 , an "and" should be added before "quinolyl".

In claim 1, under definition iv) of R^6 and R^7 , an "and" should be added after this definition but before definition v).

In claim 1, under the definitions of variables A, B, B' and W, "0" should be changed to "O".

In claim 1, under the definition of W (third line of definition), the "}" and the period after "S" should be deleted.

In claim 1, under the definition of R^1 , the slash at the end of line 2 of the definition should be deleted.

In claim 1, under the definition of R^1 , an "or" should be added before definition c).

In claim 3, variable X, and its definition, lacks antecedent basis from claim 1.

In claims 3 and 7, line 1 of each claim, "that has" should be changed to "of".

In claim 3, "R" representing hydrogen, aryl, heteroaryl, etc. lacks antecedent basis from claim 1.

In claim 3, R², R³, R⁴ and R⁵ representing halogen broadly lacks antecedent basis from claim 1.

In claim 3, for the sake of consistency from claim 1, R², R³, R⁴ and R⁵ should be changed to R², R³, R⁴ and R⁵. See claim 7 for same.

In claim 3, R⁶ representing aryl instead of aryl¹ lacks antecedent basis from claim 1.

In claim 3, for the sake of consistency from claim 1, R⁶ should be changed to R⁶. See claim 7 for same.

In claim 3, under definition iii) of R⁶, halogen broadly lacks antecedent basis from claim 1.

In claim 3, the period at the end of definition iii) of R⁶ should be deleted.

In claim 3, the period at the end of definition iv) of R⁶ should be deleted and the slash on line 4 of the definition should be deleted.

In claim 3, an "or" should be added before definition iv) of R6.

In claim 3, under definition iv) of R6, "N02 or S02-R" should be changed to "N02 and S02-R".

In claim 3, under definition iv) of R6, "S02-R" lacks antecedent basis from claim 1. See claim 7 for same.

In claim 4, variable X lacks antecedent basis from claim 1.

In claims 4 and 6, "formula II" lacks antecedent basis from claim 1.

In claim 7, the definition of Ra, Rb, Rc, Rd and Re lack antecedent basis from claims 1 and 3.

In claim 7, under the definition of Ra, Rb, Rc, Rd, Re, an "and" should be added before "Re".

In claim 7, under the definition of variable R, the substituent "ailcyl" is unclear as to its meaning and the "-S02-R group" and the "-C0-NRR' group" should be changed to "S02-R group" and "-CO-NRR' group",

respectively. Further, the slash and the "or" in the "and/or", all occurrences in each of the instant claims should be deleted.

In claim 7, there exist different definitions for the variable R. See, for instance, under the definition of Ra, Rb, Rc, Rd and Re.

In claim 8, the compound at the end of line 6 of the claim is misspelled; there is a typographical error in the compound on page 15, ninth line from the bottom of the page; etc.

A plethora of improper Markush groupings, lack of antecedent basis problems, etc. have been stated above. Applicant is strongly encouraged to carefully review and make appropriate corrections to the claims as stated above and any other changes required when responding to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/
Laura L. Stockton, Ph.D.
Primary Examiner, Art Unit 1626
Work Group 1620
Technology Center 1600

July 11, 2010